



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1459
Alexandria, Virginia 22301-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10 052,545	01 23 2002	Jarl Wikberg	1808.0010002	6521

26111 7590 06 27 2003

STERNE, KESSLER, GOLDSTEIN & FOX PLLC
1100 NEW YORK AVENUE, N.W.
WASHINGTON, DC 20005

EXAMINER

KAUFMAN, CLAIRE M

ART UNIT

PAPER NUMBER

1646

DATE MAILED: 06 27 2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/052,545

Applicant(s)

WIKBERG ET AL.

Examiner

Claire M. Kaufman

Art Unit

1646

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on 23 January 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☐ Claim(s) 54-139 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 54-139 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s) _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ 6) ☐ Other: _____

DETAILED ACTION

The preliminary amendment filed 1/23/02 has been entered.

Election/Restrictions

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 54-74 and 129-134, drawn to nucleic acid and protein of SEQ ID NO:15 and 16, vector, host cell and methods of making, classified in class 435, subclass 69.1.
- II. Claims 75-78, 97-102 and 117-122, drawn to nucleic acid of SEQ ID NO:7 and protein of SEQ ID NO:8, vector, host cell and methods of making, classified in class 435, subclass 69.1.
- III. Claims 79-84, 103-116 and 123-128, drawn to nucleic acid of SEQ ID NO:9, vector and host cell, classified in class 435, subclass 69.1.
- IV. Claims 85-90 and 135-139, drawn to drawn to nucleic acid of SEQ ID NO:1 and protein of SEQ ID NO:2, vector, host cell and methods of making, classified in class 435, subclass 69.1.
- V. Claims 91-96, drawn to drawn to nucleic acid of SEQ ID NO:5 and polypeptide of SEQ ID NO:6, vector and host cell, classified in class 536, subclass 23.1

The inventions are distinct, each from the other because of the following reasons:

Inventions I-V are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions have different structures. It is unknown what if any shared functions they have except that both SEQ ID NO:2 and 16 are MSH receptors, though different types of MSH receptors.

There is no disclosure of the full-length protein for which SEQ ID NO:10 is the partial sequence 104 amino acids-long (p. 33, especially last paragraph). While it is disclosed that SEQ ID NO:10 shares homology with the sequence of the complete MC2 receptor (MC-2R) of SEQ ID NO:16 (325 amino acids), it is only one-third the size and is not part of MC-2R. Also, SEQ ID NO:7 is 93% identical to amino acids 145-246 of SEQ ID NO:16; however, it is not identical to the above region of SEQ ID NO:16, it is not a fragment of it. There is no disclosure of the full-

Art Unit: 1646

length protein for which SEQ ID NO:8 is the partial sequence 102 amino acids-long. Similarly, SEQ ID NO:5 is not a fragment of any disclosed complete receptor sequence. On page 25, lines 17-21, the receptor of SEQ ID NO:2 is distinguished from that of SEQ ID NO:16.

Additionally, the burden of search for the Office has increased with multiple sequences because of the rapid introduction of new sequences to public sequence databases.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Claire M. Kaufman, whose telephone number is (703) 305-5791. Dr. Kaufman can generally be reached Monday through Thursday from 8:30AM to 12:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Yvonne Eyler, can be reached at (703) 308-6564.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-0196.

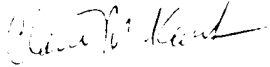
Official papers filed by fax should be directed to (703) 308-4242. Faxed draft or informal communications with the examiner should be directed to (703) 308-0294. NOTE: If applicant *does* submit a paper by fax, the original signed copy should be retained by the applicant or applicant's representative. NO DUPLICATE COPIES SHOULD BE SUBMITTED so as to avoid the processing of duplicate papers in the Office. **Please** advise the examiner at the telephone number above before facsimile transmission.

Application/Control Number: 10/052,545

Page 4

Art Unit: 1646

Claire M. Kaufman, Ph.D.

A handwritten signature in cursive script, appearing to read "Claire M. Kaufman".

Patent Examiner, Art Unit 1646

June 25, 2003